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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,633	09/16/2003	Franz Deitering	11884/407601	9755
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KENYON & KENYON LLP 1500 K STREET N.W. WASHINGTON, DC 20005			EXAMINER	
			KARDOS, NEIL R	
ART UNIT		PAPER NUMBER		
3623				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/662,633	<b>Applicant(s)</b> DEITERING ET AL.
	<b>Examiner</b> Neil R. Kardos	<b>Art Unit</b> 3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 July 2008.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-11 and 13-47 is/are pending in the application.
- 4a) Of the above claim(s) 14-20 and 36-47 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-11, 13 and 21-35 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/06)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

1. This is a **NON-FINAL** Office action on the merits in response to communications filed July 2, 2008. Claims 1, 13, 21, and 27-31 have been amended. Claim 12 has been cancelled. Claims 14-20 and 36-49 have been withdrawn. Currently, claims 1-11, 13, and 21-35 are pending. This action is NON-FINAL based on the new grounds of rejection under § 101 found below.

***Remarks***

2. Claim Rejections under § 112

Applicant's amendments to the claims are sufficient to overcome the § 112 rejections set forth in paragraph(s) 3 of the previous office action.

3. Claim Rejections under § 101

Applicant's amendments to the claims are sufficient to overcome the § 101 rejections set forth in paragraph(s) 5 of the previous office action.

4. Claim Rejections under § 102, 103

Applicant's amendments to the claims are sufficient to overcome the § 102 and § 103 rejections set forth in paragraph(s) 6-10 of the previous office action. A new grounds of rejection necessitated by these amendments is found below.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 1-11 and 13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claim 1: Claim 1 is directed toward the statutory category of a process. In order for a claimed process to be patentable subject matter under 35 U.S.C. § 101, it must either: (1) be tied to another statutory class (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *See Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method/process is not patentable subject matter under § 101. Thus, to qualify as a statutory process under § 101, the claim should positively recite the other statutory class to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g. by identifying the material that is being changed to a different state).

Here, the claimed invention does not transform underlying subject matter to a different state or thing because it merely uses survey data to determine whether strategic planning objectives are being met. Furthermore, the claimed process is not tied to another statutory category, such as a particular apparatus. Thus, the claimed invention is not patentable under § 101.

**Claims 2-11 and 13:** Dependent claims 2-11 and 13 are rejected for failing to remedy the deficiencies of the claims from which they depend.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1-3, 5, 7-11, 13, 21-32, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Havens (US 5,909,669) in view of Sanders (US 6,411,936).**

Claim 1: Havens discloses an automated business objective evaluation method, comprising:

- generating a target group of users for a survey, wherein each user of the target group has a user profile and is selected to the target group by a class identifier associated with the user profile (see col. 2: ln. 7-13, disclosing limiting survey-based assessments to selected workers; col. 4: ln. 18-41, disclosing targeting workers, peers, managers, and supervisors; col 5: ln. 58-61; col. 6: ln. 4-17, disclosing worker profiles; col. 11: ln. 28-49);
- aggregating survey results data with other business data into a business information warehouse, wherein the other business data are acquired via means other than the survey (see figure 2: items 12-18; col. 6: ln. 18-57, disclosing aggregating survey results data with benchmark data)

- responsive to an indicator of business performance, extracting a segment of survey results data corresponding to the indicator (see col. 6: ln. 58 through col. 7: ln. 5; col. 7: ln. 22-57; col. 8: ln. 10-25; col. 12: ln. 17-27; col. 1: ln. 14-22 and 27-29);
- comparing the extracted segment to an aggregate set of survey results data (see col. 6: ln. 33-57; col. 8: ln. 10 through col. 9: ln. 22, describing the comparator; col. 13: ln. 38-55);
- identifying any survey results data from the extracted segment that statistically differ from responding results data from the aggregate set by a predetermined amount (see col. 7: ln. 36-49; col. 8: ln. 26-49; col. 9: ln. 9-43, disclosing identifying disparities with respect to a standard deviation);
- linking the identified statistically different survey results data to business key values in the business information warehouse (see col. 7: ln. 22-57; col. 8: ln. 26 through col. 9: ln. 43; Specifically, col. 9: ln. 23-43, disclosing linking disparities to productivity).

Havens does not explicitly disclose E-surveys. However, Examiner takes Official Notice that E-surveys were old and well-known in the art at the time the invention was made. Thus, the elements and their functions are known in the prior art, albeit in separate references (or in this case, the Havens reference and Official Notice). The difference between the claimed subject matter and the prior art rests not on any individual element or function, but on the combination itself. That is, in the substitution of E-Surveys as known in the art for paper surveys as disclosed

by Havens. The simple substitution of one known element for another producing a predictable result renders the claim obvious.

Havens also does not explicitly disclose determining whether objectives of strategic enterprise management planning are being met. Presumably the worker productivity assessment described by Havens is undertaken in order to improve worker productivity, which would likely be an objective of a strategic management plan. Sanders discloses using surveys (see e.g. col. 13: ln. 6-15; col. 14: ln. 5-10) in conjunction with performance metrics (see e.g. col. 14: ln. 41-54) and key value drivers (see e.g. col. 12: ln. 28-57) in order to meet strategic planning objectives (see e.g. col. 2: ln. 5-23; fig. 5: item 509; col. 13: ln. 45-49; col. 14: ln. 31-54; col. 15: ln. 4-17). Havens and Sanders both relate to improving a business through the use of surveys. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the methodology of Havens to determine whether strategic objectives are being met, as taught by Sanders. One of ordinary skill in the art would have been motivated to do so for the benefit of improving productivity and efficiency (see Sanders: col. 8: ln. 18-22).

Claim 2: Havens discloses wherein the indicator identifies an organizational unit of a business experiencing anomalous performance (see col. 7: ln. 22-57, disclosing segmenting parameters of surveys via numerical range; col. 8: ln. 26 through col. 9: ln. 8).

Claim 3: Havens suggests wherein the indicator identifies a period of time (see col. 1: ln. 27-29).

Claim 5: Havens discloses wherein the indicator is a key performance indicator (see col. 7: ln. 22-57, disclosing segmenting parameters of surveys including worker criteria and information criteria).

Claim 7: Havens discloses wherein the indicator is an employee satisfaction indicator (see at least col. 4: ln. 33-37).

Claim 8: Havens discloses wherein the aggregate set is survey results data for a business and the extracted segment is a portion of the aggregate set (see col. 6: ln. 18-57).

Claim 9: Havens suggests wherein the aggregate set is survey results data for a market in which the business participates (see col. 1: ln. 19-22; col. 6: ln. 18-57).

Claim 10: Havens discloses comparing the extracted segment of survey results data to historical data (see col. 6: ln. 33-39).

Claim 11: Havens discloses comparing the extracted segment of survey results data to external benchmarks (see col. 6: ln. 18-57).

Claim 13: Havens discloses wherein the business key values are at least one of sales revenues, turn over rates, profit statistics, cost statistics, quality statistics, customer satisfaction rates and illness rates (see figure 1, disclosing quality statistics and customer satisfaction rates).

Examiner also notes that Sanders discloses revenues and cost statistics as key value drivers (see figure 5: items 519-521).

Claims 21, 23-24, 27, and 30: Claims 21, 23-34, 27, and 30 are substantially similar to claim 1, except that they are directed to a system. Havens discloses such a system (see e.g. figure 2; col. 10: ln. 9-22). Thus, claims 21, 23-24, 27, and 30 are rejected under similar rationale as claim 1.

Claim 22: Havens does not explicitly disclose wherein the output manager is to permit access to the generated result based on pre-determined access rights. However, Examiner takes Official Notice that it was well-known in the arts at the time the invention was made to grant permission to information based on access rights (e.g. via a login password). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to protect the information reported in Havens by using pre-determined access rights as is well-known in the art. One of ordinary skill in the art would have been motivated to do so for the benefit of increased security.

Claim 25: Claim 25 is substantially similar to claim 8 and is rejected under similar rationale.

Claim 26: Claim 26 is substantially similar to claim 9 and is rejected under similar rationale.

Claim 28: Claim 28 is substantially similar to claim 10 and is rejected under similar rationale.

Claim 29: Claim 29 is substantially similar to claim 11 and is rejected under similar rationale.

Claim 31: Claim 31 is substantially similar to claim 13 and is rejected under similar rationale.

Claims 32 and 34: Claims 32 and 34 are substantially similar to claims 3 and 5, respectively, and are rejected under similar rationale.

**9.       Claims 4, 6, 33, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Havens in view of Sanders, and further in view of Nelson (US 7,233,908).**

Claims 4 and 6: Havens and Sanders do not explicitly disclose wherein the indicator identifies a geographic region (claim 4) or customer satisfaction (claim 6).

Nelson discloses wherein the indicator identifies a geographic region (see col. 5: ln. 60-62, disclosing comparing regions; figure 9: item 292; col. 6: ln. 6, disclosing comparing satisfaction by site) and wherein the indicator is a customer satisfaction indicator (see figures 8 and 11).

Havens, Sanders, and Nelson are all directed to conducting surveys for evaluative purposes. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the indicators taught by Nelson for the purpose of comparative evaluations as taught by Havens. One of ordinary skill in the art would have been motivated to do so for the benefit of increased flexibility and adaptability in the comparison process.

Claims 33 and 35: Claims 33 and 35 are substantially similar to claims 4 and 6, respectively, and are rejected under similar rationale.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. Kardos whose telephone number is (571) 270-3443. The examiner can normally be reached on Monday through Friday from 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Neil R. Kardos  
Examiner  
Art Unit 3623

NRK  
9/8/08  
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